

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) TRI04546P00161US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 30, 2008</u> Signature <u>Karen Sanderson</u>		Application Number 10/692,703	Filed October 24, 2003
		First Named Inventor Joseph M. Koenig, Jr.	
Typed or printed name <u>Karen Sanderson</u>	Art Unit 3723	Examiner Maurina T. Rachuba	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

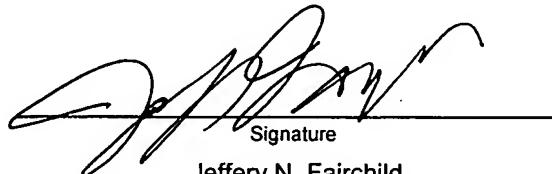
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.
 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
 attorney or agent of record.
Registration number 37,825
 attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Jeffery N. Fairchild

Typed or printed name

312/876-1800

Telephone number



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input checked="" type="checkbox"/>	*Total of <u>2</u> forms are submitted.
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TRI04546P00161US
PATENT

STATEMENT FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-12 are pending and at issue. Claims 1, 2, 5 and 9 stand rejected as unpatentable over Kingman 2,386,900 in view of Meyer 5,439,545; and claims 3, 4, 6-8 and 10-12 stand rejected as unpatentable over Kingman in view of Meyer as applied to claim 1, and further in view of Hays 2,553,254.

The clear error in the rejections is the improper modification of Kingman with Meyer, and the failure to state any rationale or cite any evidence whatsoever for the proposed modification of Kingman with Hays.

The Rejection Ignores the Express Teachings of Kingman and Proposes a Modification That Is Contrary to These Express Teachings

The prior art must be considered in its entirety, including disclosures that teach away from the claims, and references cannot be combined where references teach away from their combination (see MPEP §2145 D), Kingman expressly states that it's object is to provide a scouring device having "a substantially rigid body or core" (Kingman, col. 1, lines 8-1) and consistent with this object, repeatedly teaches that it's scouring device should have a rigid body or block (see, for example, col. 1, lines 41-46 and the first line of each of claims 1-5). In this regard, the requirement for a "rigid block" in each of the claims cannot be ignored because it is the claims that describe the invention and Kingman expressly requires "a rigid block" in every single claim defining its invention. Despite this overwhelming showing in Kingman, the present Office Action continues to assert that it would be obvious to replace the rigid block required for the invention of Kingman with a

non-rigid body as allegedly taught by Meyer. It is that specific substitution required by the proposed modification in rejecting the claims that is expressly taught away from by Kingman's requirement that it have a substantially rigid body or core. For this reason alone, the proposed modification in the rejection is improper and should be withdrawn.

In response to the above argument, the present Office Action asserts that "It is the Examiner's position that Kingman therefor teaches the desirability of providing at least part of the tool with a material that is flexible and compressible." (emphasis added) However, this assertion conveniently ignores Kingman's very express teaching that "at least part of the tool" be made from a rigid material, and specifically that the body of the tool be "a rigid block". In making a rejection, the Examiner is not allowed to simply ignore portions of the prior art that are inconvenient for the arguments asserted by the Examiner.

The current Office Action goes on to assert that "There is no teaching against providing at least part of the tool of a flexible and compressible material." Again, this assertion ignores the fact that there is an express teaching in Kingman against providing an entire tool of a flexible and compressible material such as is proposed in the rejection.

The present rejection also asserts that "it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand tool that conforms to the shape of the workpiece." (emphasis added) However, this benefit is already expressed achieved by the structure in Kingman. In this regard, Kingman expressly states at column 3, lines 45-54 that "Since the coating 19 of the device is, per se, of resilient character, the same will sufficiently yield under pressure toward the surface

undergoing treatment as to assure intimate conforming contact therewith, and so as to further assure that the abrasive material or grit 20 carried thereby will be brought into intimate and firm scraping and scouring engagement with said surface, when the device is rubbed back and forth over the latter." Thus, Kingman's disclosure that "the material of the tool" was "selected to conform to the shape of the workpiece" could not be any clearer, and the benefit argued in the rejection is thus already expressly achieved by the unmodified structure in Kingman. It cannot be obvious to modify a structure to provide a benefit that is already provided by the structure. In this regard, it should be noted that no rationale is provided in the rejection as to why the proposed modification would provide a superior result with respect to conforming to the shape of the workpiece than what is already expressly achieved by Kingman.

The present Office Action also asserts that "Meyer clearly teaches making a tool with the entire tool being made of a material that is flexible and compressible, to allow the entire tool to conform to the surface being abraded." However, this assertion ignores that Kingman teaches exactly the opposite of this by requiring a rigid body or block. Kingman cannot be modified contrary to its express teachings, regardless of what Meyer may or may not teach.

Accordingly, for each of these additional reasons, the rejections based on the modification of Kingman with Meyer is improper and should be withdrawn, including the rejection of claims 3, 4, 7 and 8.

**The Rejection Fails to State Any Rationale Whatsoever
for the Further Modification of Kingman with Hays**

The present Office Action fails to state any rationale or cite any evidence whatsoever for its proposed modification of Kingman with Hays. Indeed, no Office Action in this case has provided such a rationale, despite numerous and express requests for such a rationale. Rather, the rejection acknowledges the shortcomings of its combination of Kingman and Meyer with respect to claims 3, 4, 6-8 and 10-12, and then discusses the structure allegedly disclosed by Hays, without any statement whatsoever as to why one skilled in the art would further modify Kingman with the disclosure of Hays. Absent such a rationale, the rejection fails to meet the standards set forth in the MPEP for stating a *prima facie* case of obviousness and accordingly, it is improper and should be withdrawn. For this additional reason, it is believed the rejection of claims 3, 4, 6-8 and 10-12 is improper.

In view of the foregoing, Applicant respectfully requests reconsideration of the finality of the rejection and the rejections of claims 1-12, and allowance of the case.